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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/354,726	12/06/94	SOUDA	S 42327

12M1/0115

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EXAMINER
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FAN, J	
ART UNIT	PAPER NUMBER
1203	13

DATE MAILED:

01/15/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 10/7/96

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 18-19 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 18-19 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s): \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

Art Unit: 1203

Claims 18-19 are rejected under 35 USC 103 as being unpatentable over EP 074,341 in view of EP 198,208. Applicants' remarks and data have been carefully considered, but are deemed unpersuasive for the following reasons:

1. The significant difference between the facts presented in *In re Magerlein* with respect to this case is that the intermediate in *In re Magerlein* could not be used in any other manner but to make the final product. In significant contrast, the claimed intermediate has other uses (treating gastric disorders) besides to be used to make the final product.

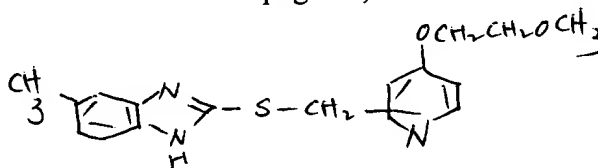
2. The data has been considered but are not convincing:

A. It does not have any probative value since it is not in declaration form.

B. It is not complete. There are only pages 13-17 stopped at the middle of the tests.

C. The compounds compared are not the closest compounds.

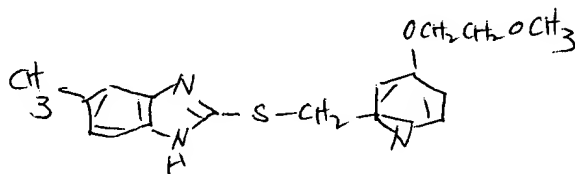
The art compound in EP 074341 page 20, ex. 27 should have been compared.



D. The unexpected advantage (antibiotic use) is not disclosed in the original specification. See *In re Davies*, 177 USPQ 381. If applicants disagree to this fact applicants are requested to point out the antecedent basis wherein antibiotic properties are disclosed in the specification by page number and line numbers.

Art Unit: 1203

In order to overcome this rejection applicants are required to show unexpected advantages (disclosed in the specification) over the closest art compound:



Claims 18-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 5,045,552 in view of GB 2,134,523. Note S and S are interchangeable for compounds of the same use in GB 2,134,523, page 1 left col. Line 48.


Claims 18-19 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim of copending application Serial No. 07/679,473.

Claims 18-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim of copending application Serial No. 07/679,473.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JANE FAN whose telephone number is (703) 308-4705.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

JTF January 9, 1997

  
JANE FAN  
PRIMARY EXAMINER  
GROUP 1203